

said circuitry further configured to compare the sum of the individual counter and the central counter to a predetermined threshold and either award a bonus game win if the threshold is satisfied or increment the central counter if the threshold is not satisfied.

28. (New) The networked gaming system according to claim 27, wherein the circuitry is further configured to perform the award of the bonus game win and the increment of the central counter without requiring input from a player of any of the gaming machines.

REMARKS

Claims 1-4 and 6-20 are active and pending in the present application. Claims 1-4 and 6-20 stand rejected under the first paragraph of 35 USC 112. Claims 1-4 and 6-16 stand rejected under 35 USC 103 as unpatentable over Marnell II in view of Manship and further in view of Thomas et al.. Claims 1-4, 6, 8-11 and 13-16 stand rejected under 35 USC 102 as anticipated by Thomas et al. Claims 7 and 12 stand rejected under 35 USC 103 as unpatentable over Thomas in view of Marnell II. In response, Applicants provide the following remarks and have added new claims 21-28. Care was exercised to ensure that no new subject matter has been improperly introduced.

Rejection under 112||1 and Objection under 35 USC 132

Applicants urge that the claim amendments presented in the previous response dated September 26, 2002 do not improperly introduce new subject matter and that the

claims, as then revised, contain subject matter that is described in the specification in such a way as to reasonably convey to a skilled artisan that the inventors had possession of the claimed invention when the application was filed.

In stating this rejection, the Examiner relies on the embodiments of FIG. 7 and FIG. 8 to conclude that the only bonus game described within the specification is a random game. Applicants urge that previous figures, such as FIG. 3 and FIG. 4, describe non-random generation of the bonus game result.

Claim 1 recites "**if said first game result meets certain criteria, [then] initiating a bonus game".**

- FIG. 3 shows a test step **308** that determines whether a symbol combination is a bonus hit. If not, then regular play continues with step **312**. If the test is satisfied, however, logical flow continues with steps **316, 318 and 314**.
- FIG. 4 shows the same test step **308** and regular play step **312**. In this embodiment, however, a bonus hit conditions causes logic flow to proceed with steps **420, 424, 428 and 314**.

Claim 1 then recites "**said bonus game being other than a random game.**"

- The bonus game steps of FIG. 3 involve step **316** which sums two non-random numbers; step **318** which tests the resulting sum value against a predetermined threshold; and steps **314 and 320** which either pay an award or increment a counter.

- The bonus game steps of FIG. 4 involve step **420** which increments a counter; step **424** which sums two non-random numbers; step **428** which tests a predetermined value against a threshold; and steps **314 and 432** which either pay an award or increment a counter.

There is no randomness in generating the result of the bonus game, once it is initiated, in either of the embodiments of FIG. 3 or FIG. 4. Applicants urge, therefore, that the specification as originally filed would reasonably convey to a skilled artisan that the bonus game is "other than a random game" as recited in claims 1 and 4. The language of claim 17 is similar in that it recites "wherein the bonus game comprises non-randomly generating a bonus game result." As explained above, Applicants urge that the original specification, for example FIGs. 3 and 4, would reasonably convey to a skilled artisan that the inventors had possession of a bonus game which included non-randomly generating a bonus game result at the time this patent application was originally filed.

Applicants urge that the present claims and specification satisfy the requirements of the first paragraph of 35 USC 112 and those of 35 USC 132. Accordingly, reconsideration and withdrawal of the rejections and objections of claims 1-4 and 6-20 are respectfully requested.

Rejection under 102 over Thomas et al.

Applicants urge that Thomas et al. do not identically disclose each and every feature recited in claims 1-4, 6, 8-11 and 13-16. In particular, the bonus game of Thomas et al. is not "other than a random game" as recited in claims 1 and 4. FIGS. 8 and 9

illustrate the bonus game of Thomas et al. which is a grid of hidden outcomes, one of which is selected by a user during an interactive bonus game. Since the user's selection of a grid square is unknown and is not predictable with any degree of certainty, this aspect of requiring the user's input cannot be characterized as non-random. Furthermore, the generation of the grid itself is an entirely random event controlled by the gaming machine. See, for example, column 10, lines 7-11, which states that "... the placement of the outcomes in the grid ...is randomly determined by the game controller." (Emphasis added).

Accordingly, Thomas et al. do not identically disclose a bonus game which is "other than a random game", as required by claims 1 and 4. Thomas et al. therefore do not provide the factual basis necessary to support the rejection under 35 USC 102 of claims 1-4, 6, 8-11 and 13-16. Reconsideration and withdrawal of the rejection of these claims are respectfully requested.

Rejection under 103 over Marnell II, in view of Manship and further in view of Thomas

Claims 1-4 and 6-20 stand rejected under 35 USC 103 over Marnell in view of Manship and further in view of Thomas et al. The Examiner asserts that Marnell discloses the invention substantially as recited in the claims but does not disclose presenting both outcomes on the same display screen nor a non-random bonus game. Manship is relied upon as purportedly showing a single display and Thomas et al. are relied upon as purportedly showing a non-random bonus game. The Examiner concludes it would have been obvious to combine these three references "in order to provide control to the players and therefore heighten the excitement of the game."

As explained above, Applicants urge that careful consideration of the Thomas et al. system reveals that the bonus game result of Thomas et al. is random. Applicants agree with the Examiner that neither Marnell nor Manship disclose a non-random bonus game. Thus, the combination of these three references does not disclose or suggest "a bonus game, being other than a random game" as required by claims 1, 4 and 17. As the combination of references does not disclose or suggest all the limitations of these claims, it does not provide the factual support needed to properly establish a prima facie case of obviousness under 35 USC 103. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 USC 103 of claims 1-4 and 6-20.

Rejection under 103 over Thomas et al. in view of Marnell

The Examiner asserts that Thomas et al. anticipate the underlying base claims but admits that they do not disclose symbols representing playing cards as recited in claims 7 and 12. As explained above, Applicants urge that Thomas et al. do not disclose a bonus game being other than a random game as recited in the claims 1 and 4. As claims 7 and 12 include all the limitations of their base claim (i.e., claim 4 and 1, respectively), the combination of Thomas et al. and Marnell do not disclose or suggest all the limitations of claims 7 and 12 and, therefore does not provide the factual support needed to properly establish a prima facie case of obviousness under 35 USC 103. Reconsideration and withdrawal of the rejection under 35 USC 103 of claims 7 and 12 are respectfully requested.

Newly Added Claims

Claims 21-23 recite that, unlike Thomas et al., no user input is required within the bonus game in order to generate the bonus game result. Claims 24-26 explicitly recite a bonus game which includes steps substantially similar to those depicted in the embodiments of figures 3 and 4. Claims 27 and 28 recite a network of machines which each contribute to the bonus game. The subject matter for all of these claims finds support in the original specification as filed an, therefore, Applicants urge that no new matter is being improperly introduced.

SUMMARY

In view of the above remarks and amendments, APplciants believe that claims 1-4 and 6-28 are in condition for allowance and passage of this case to issue is respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this

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paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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